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ATTEN: BRIAN FURRER ONDA TECHNO INTL. PATENT ATTYS. 12-1, OMIYA-CHO 2-CHOME GIFU-CITY, 500-8731 JAPAN				
EXAMINER				
AKINTOLA, OLABODE				
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/682,583
Filing Date: September 21, 2001
Appellant(s): BROTHERSTON, DAVID N.

Brian Furrer
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 8, 2008 appealing from the Office action mailed August 11, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,311,302	Berry et al	05-1994
5,444,444	Ross	08-1995
5,845,263	Camaisa et al	12-1998

6,026,375	Hall et al	02-2000
5,646,389	Bravman et al	07-1997
5,979,757	Tracy et al	11-1999
5,850,433	Rondeau	12-1998
6,201,797	Leuca et al	03-2001
5,727,163	Bezos	03-1998
6,122,620	Weber	09-2000
6,249,774	Roden et al	06-2001
5,526,481	Parks et al	06-1996

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berry (US 5311302) in view of Ross (US 5444444) ("Ross").

Re claim 1: Berry teaches a system comprising: (a) a plurality of computers that include an onboard computer transported with the vehicle (abstract, figures, col. 3, lines 4-54).

Berry does not explicitly teach an external computer not transported with the vehicle; (b) software installed on the onboard computer, the onboard computer software being operable on the onboard computer for causing the onboard computer to perform tasks including: i) obtaining service information from the external computer via communication with the external computer if a communication pathway to the external computer is open; and ii) providing access to service information by personnel for fulfillment of the service orders; and (c) software installed on the external computer, the external computer software being operable on the external computer for causing the external computer to perform tasks including: i) acquiring information to determine the available services provided ; and ii) managing the delivery of services ; and iii) making service information obtainable by the onboard computer.

Ross teaches an on board computer transported in a vehicle (col. 3, lines 25-29; controller 10), and an external computer not transported with the vehicle (col. 3, lines 65 through col. 4, line 6; controller 22); (b) software installed on the onboard computer, the onboard computer software being operable on the onboard computer for causing the onboard computer to perform tasks including: i) obtaining service information from the external computer via communication with the external computer if a communication pathway to the external computer is open; and ii)

providing access to service information by personnel for fulfillment of the service orders (col. 3, lines 25-55); and (c) software installed on the external computer, the external computer software being operable on the external computer for causing the external computer to perform tasks including: i) acquiring information to determine the available services provided ; and ii) managing the delivery of services ; and iii) making service information obtainable by the onboard computer (col. 3, lines 65 through col. 4, line 22).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include these steps. One would have been motivated to do this in order to monitor and coordinate delivery of products to recipient.

Re claim 2: Berry teaches requests for delivery of products to passengers, managing delivery of products in accordance with service order and billing of passengers for fulfillment of service orders (abstract, fig. 1, col. 3, lines 4-54).

Re claim 3: Berry teaches associating a seat with each service order (abstract, figs)

Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berry in view of Ross, and further in view of Camaisa et al (US 5845263) ("Camaisa")/ Hall et al (US 6026375) ("Hall").

Re claims 4 and 14: Berry does not explicitly teach accepting service orders prior to boarding and associates each service order with a vehicle departure and makes the information

obtainable by the onboard computer. Camaisa/Hall teaches accepting service orders prior to boarding and associates each service order with a vehicle departure and makes the information obtainable by the onboard computer (Camaisa: col. 4, lines 17-23, col. 17, lines 8-17; Hall: col. 2, lines 32-35). It would have been obvious to one of ordinary skill in the art at the time of the invention to include this step. One would have been motivated to do this in order to direct services to appropriate seat/facility/location to coincide with customer's arrival.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berry in view of Ross, and further in view of Roden et al (US 6249774) ("Roden").

Re claim 5: See claim 1 analysis, supra. Berry does not explicitly teach the step wherein the external computer software is further operable on the external computer for analyzing at least one of historical service order information and currently entered service order information, and based on the analysis recommends vehicle inventory. Roden teaches the step wherein the external computer software is further operable on the external computer for analyzing at least one of historical service order information and currently entered service order information, and based on the analysis recommends vehicle inventory (col. 7, lines 20-36, abstract). It would have been obvious to one of ordinary skill in the art at the time of the invention to include this step. One would have been motivated to do this in order to recommend replenishing item list.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berry in view of Ross, and further in view of Bravman et al (US 5646389) ("Bravman").

Re claim 6: Berry further teaches request for delivery of products (abstract, fig. 1, col. 3, lines 4-54). Berry does not explicitly teach managing flow of inventory from a terminal to a vehicle and from other sources to the terminal. Bravman teaches this feature (col. 2, lines 49-62; figs.). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Berry to include this feature. One would have been motivated to do so in order to ensure on-time delivery of products at their destination points.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berry in view of Ross, and further in view of Tracey et al (US 5979757) ("Tracey").

Re claim 25: Berry does not explicitly teach handheld computers used by vehicle personnel for creating and accessing service orders on the on board computer by communication between the handheld computer and the onboard computer. Tracey teaches this limitation (col. 3, lines 49-67; col. 15, lines 17-21). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Berry to include this feature. One would have been motivated to do so in order to allow attendant access orders using a portable terminal.

Claims 7 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berry in view of Rondeau (US 5850433) ("Rondeau").

Re claims 7 and 12: Berry teaches a system for fulfilling service orders on a transport vehicle, the system comprising an onboard computer transported with the vehicle and connections with electronic devices operated by vehicle personnel or passengers (abstract, col. 3, lines 4-54), the onboard computer including software, which when operated on the onboard computer and electronic devices causes the onboard computer to perform tasks comprising accepting service orders entered via the electronic devices by vehicle personnel or passengers and making the service orders accessible to vehicle personnel (abstract, col. 3, lines 4-54). Berry does not explicitly teach providing menu options adapted for specific customer preferences that vary based on preselected products and services and historical preference. Rondeau teaches customizing customer menu based on historical usage (abstract). It would have been to one of ordinary skill in the art at the time of the invention to modify Berry to include the step of customizing customer menu based on customer profile as taught by Rondeau. One would have been motivated to do so in order to personalize the menu presented to the passenger based on passenger's profile.

Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berry in view of Rondeau, and further in view of Tracey et al (US 5979757) ("Tracey").

Re claims 10 and 11: Berry does not explicitly teach handheld computers used by vehicle personnel for creating and accessing service orders on the on board computer by communication between the handheld computer and the onboard computer. Tracey teaches this limitation (col. 3, lines 49-67; col. 15, lines 17-21). It would have been obvious to one of ordinary skill in the art at

the time of the invention to modify Berry to include this feature. One would have been motivated to do so in order to allow attendant access orders using a portable terminal employing wireless communication.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berry in view of Rondeau, and further in view of Ross.

Re claim 13: See claims 1, 2 and 7 analyses, *supra*.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berry in view of Rondeau in view of Ross, and further in view of Camaisa/ Hall.

Re claim 14: See claims 4 and 13 analyses, *supra*.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berry in view of Rondeau in view of Ross, and further in view Leuca et al (US 6201797) ("Leuca")

Re claim 15: Berry does not explicitly teach the step wherein if a service order includes a request for Internet access, the onboard computer provides Internet access to a connection at a passenger seat location corresponding to the service order, by making use of said communication route.

Leuca teaches wherein if a service order includes a request for Internet access, the onboard computer provides Internet access to a connection at a passenger seat location corresponding to the service order, by making use of said communication route (col. 2, lines 7-12). It would have

been obvious to one of ordinary skill in the art at the time of the invention to modify Berry to include this step. One would have been motivated to do this in order to provide internet access to passengers while onboard.

Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berry in view of Bezos (US 5727163) ("Bezos").

Re claims 8 and 9: Berry teaches a system for fulfilling service orders on a transport vehicle, the system comprising an onboard computer transported with the vehicle and connections with electronic devices operated by vehicle personnel or passengers (abstract, col. 3, lines 4-54), the onboard computer including software, which when operated on the onboard computer and electronic devices causes the onboard computer to perform tasks comprising accepting service orders entered via the electronic devices by vehicle personnel or passengers and making the service orders accessible to vehicle personnel (abstract, col. 3, lines 4-54). Berry does not explicitly teach that the electronic devices include passenger supplied personal information processing apparatus carried on by the passenger. Bezos teaches using a laptop or PDA to place an order. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Berry to include this feature. One would have been motivated to do so in order to incorporate portable device as an alternative to fixed device.

Claims 16-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berry in view of Ross in view of Camaisa in view of Roden in view of Rondeau and further in view of Weber (US 6122620) ("Weber").

Re claims 16-17: Berry, Ross, Camaisa, Rondeau and Roden teach the limitations of claims 16-17, except the step of accessing database information pertaining to vehicle departure and destination. Berry teaches a system for fulfilling orders on a transport vehicle. Berry does not explicitly teach an external computer not transported with the vehicle, the external computer including software being operable on the external computer for causing the external computer to perform tasks comprising: a) accessing database information pertaining to vehicle departure, destination, past services orders and inventory information; b) based on the database information, estimating service orders expected to be received and recommended inventory for transport for onboard fulfillment of service orders and providing menu options adapted for specific customer preferences that vary based on pre-selected products and services and historical preferences. Ross is cited for teaching external computer not transported with the vehicle, the external computer including software being operable on the external computer for causing the external computer to perform tasks comprising accessing database information including routing information (see claim 1 analysis). Roden is cited for teaching past services information and inventory information and analyzing this information to recommend vehicle inventory (see claim 5 analysis). Rondeau is cited for teaching customizing customer menu based on historical usage (see claim 7 analysis). Berry, Ross, Camaisa, Rondeau and Roden do not explicitly teach the step of accessing database information pertaining to vehicle departure and destination.

Weber teaches the step of accessing database information pertaining to vehicle departure and destination (col. 1, lines 53-65, col. 2, lines 34-40 and 55-67). It would have been obvious to one of ordinary skill in the art at the time of the invention to include this step. One would have been motivated to do this in order to collect and disburse information regarding flight information.

Re claims 18 and 19: Camaisa teaches the step wherein the other computers include kiosks at terminal areas (col. 6, lines 27-52).

Re claim 20: See claims 4 and 5 analyses, supra.

Re claim 21: See claim 5 analysis, supra.

Re claim 22 and 24: See claim 1 analysis, supra.

(10) Response to Argument

The Examiner summarizes the various points raised by the Appellant and addresses them individually.

#1: Reopening of Prosecution after Final Rejection.

1. Appellant argues that the Examiner's reopening of prosecution is improper since no new ground(s) of rejection was introduced.

In Response: The Examiner respectfully disagrees. In the office action (non final) dated 09/07/2007, Examiner inadvertently omitted claim 9 in the office action. Examiner subsequently issued a final office action dated 01/10/2008 addressing all issues raised by the Appellant including the omission of claim 9 in the previous office action as noted in the Appellant Remarks/Arguments dated 12/07/2007. Appellant filed an Appeal Brief dated 06/10/2008 raising the same issue (omission of claim 9) among others to be determined by the Board. Specifically, on page 11 of 37 of the Appeal Brief of 06/10/2008, Appellant asserts that the "Examiner violated Applicant's due process rights by failing to provide sufficient notice for reason for rejection of claim 9 and an opportunity to be heard regarding those reasons prior to issuing a Final Office Action".

For this reason, Examiner after due consultation with the Appeal Brief Specialist, reopened the prosecution so that the Appellant due process right is restored by providing sufficient notice for the rejection of claim 9 and an opportunity to be heard regarding those reasons prior to issuing a Final Office Action.

#2: Rejection of claims 1-3 under 35 U.S.C. § 103(a) over Berry in view of Ross.

1. Regarding claim 1 (representing claims 1-3), Appellant argues that Berry/Ross combination is improper because the Examiner ignored claim recitation that the combination does not meet. Specifically, Appellant argues that Ross does not teach (c) software installed on the external computer, the external computer software being **operable** on the external computer for causing the external computer to perform tasks including: i) acquiring information to determine the available services provided *on the transport vehicle*; and ii) managing the delivery of services; and iii) making service information obtainable by the onboard computer.

In Response: Examiner respectfully disagrees with Appellant assertion. Examiner asserts that the various tasks (i.e., c(i)-c(iii)) that are *operably* performed by the software on the external computer are considered as intended use of the software; a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Furthermore, Ross teaches a path for communicating delivery status information between the on board computer and the external computer.

#3: Rejection of claims 4 and 14 under 35 U.S.C. § 103(a) over Berry in view of Ross and further in view of Camaisa/Hall.

1. Regarding claims 4 and 14, Appellant argues that Camaisa and Hall do not teach software operable on the external computer for accepting service orders prior to boarding and associates

each service order with a vehicle departure and makes the information obtainable by the onboard computer.

In Response: Examiner respectfully disagrees with Appellant assertion. Examiner asserts that the further tasks (i.e., for accepting service orders prior to boarding and associates each service order with a vehicle departure and makes the information obtainable by the onboard computer) that are *operably* performed by the software on the external computer are considered as intended use of the software; a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Furthermore, Hall teaches the concept of accepting orders and scheduling the completion of an order to coincide with the customer's arrival at a local facility. Camaisa also teaches the concept of ordering food from a remote location and securing a reservation before arriving at the restaurant at a specified time.

#4: Rejection of claim 5 under 35 U.S.C. § 103(a) over Berry in view of Ross and further in view of Roden

1. Regarding claim 5, Appellant argues that Ross and Roden do not teach software operable on the external computer for analyzing at least one of historical service order information and currently entered service order information, and based on the analysis recommends vehicle inventory.

In Response: Examiner respectfully disagrees with Appellant assertion. Examiner asserts that the further tasks (i.e., for analyzing at least one of historical service order information and currently entered service order information, and based on the analysis recommends vehicle inventory) that are *operably* performed by the software on the external computer are considered as intended use of the software; a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Furthermore, Roden teaches the concept of analyzing history order information with current level of inventory replenish the items.

#5: Rejection of claim 6 under 35 U.S.C. § 103(a) over Berry in view of Ross in view of Bravman

1. Regarding claim 6, Appellant argues that Bravman does not teach terminals for a transport vehicle as recited in claim 1, from which claim 6 depends.

In Response: Examiner respectfully disagrees. Bravman teaches the concept as articulated in the rejection.

#6: Rejection of claim 25 under 35 U.S.C. § 103(a) over Berry in view of Ross in view of Tracy

1. In response to applicant's argument that the examiner's conclusion of obviousness is conclusory and not articulated, KSR forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. See the Board decision *Ex parte*

Smith, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007)(citing KSR, 82 USPQ2s at 1396).

#7: Rejection of claims 7 and 12 under 35 U.S.C. § 103(a) over Berry in view of

Rondeau

1. Regarding claim 7, Appellant argues that Berry and Rondeau do not teach “providing menu options *adapted for* specific customer preferences that vary based on preselected products and services and historical preference.

In Response: Examiner respectfully disagrees with Appellant assertion. Examiner asserts that the phrase *adapted for* is considered as intended use of the menu option; a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Furthermore, Rondeau teaches customizing customer menu based on historical usage.

#8: Rejection of claims 10 and 11 under 35 U.S.C. § 103(a) over Berry in view of

Rondeau

1. In response to applicant's argument that the examiner's conclusion of obviousness is conclusory and not articulated, KSR forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. See the Board decision *Ex parte Smith*, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007)(citing KSR, 82 USPQ2s at 1396).

#9: Rejection of claim 13 under 35 U.S.C. § 103(a) over Berry in view of Rondeau, and further in view of Ross

1. Appellant argument is similar to claims 1 and 7 arguments above. Examiner maintains the same response to argument as recited in issues #2 and #7 above.

#10: Rejection of claim 14 under 35 U.S.C. § 103(a) over Berry in view of Rondeau in view of Ross, and further in view of Camaisa/Hall

1. Appellant argument is similar to claims 4 and 13 arguments above. Examiner maintains the same response to argument as recited in issues #2, #3 and #7 above.

Furthermore, Appellant asserts that Examiner's reasoning for the rejection does not make sense. Examiner disagrees. Claim 14 depends on claim 13, which remains rejected under 35 USC 103(a) over Berry, Rondeau and Ross. However, claim 14 includes additional limitation similar to claim 4 limitation that is taught by Camaisa/Hall. Essentially, claim 14 is a combination of claims 13 and 4.

#11: Rejection of claim 15 under 35 U.S.C. § 103(a) over Berry in view of Rondeau in view of Ross, and further in view of Leuca

1. Appellant argues that Leuca fails to teach the limitation of claim 15. Examiner respectfully disagrees. Leuca teaches this feature at col. 2, lines 7-12.

#12: Rejection of claims 8 and 9 under 35 U.S.C. § 103(a) over Berry in view of

Bezos

1. Regarding claim 8, Appellant argues that modifying Berry to include the teachings of Bezos would be redundant and defeats the intended purpose of the Berry.

In Response: Examiner respectfully disagrees with Appellant assertion. Bezos teaches an electronic device including a user supplied personal information processing apparatus carried on by a user. Examiner introduced the Berry reference to show that the concept of having a portable personal information processing apparatus carried on by users is old and well known. One of ordinary skill in the art would recognized that the result of modifying Berry to include this feature were predictable.

2. Regarding claim 9, Appellant argues that wireless connectivity (with respect to PDAs) was not considered to be common knowledge or well known in the art at the time of the effective filing date of the instant application. Appellant also requested that the Examiner provide documentary evidence if the rejection is to be maintained (Appeal Brief, Pgs 35).

In Response: Examiner assert that Support for this feature can be found in Parks et al (US 5,526,481, effective filing date of **07/26/1993**) at col. 1, lines 33-36 "*PDAs are wireless, hand-held electronic devices that may be connected to a desktop personal computer (PC) or other PDAs via an infrared link*".

**#13: Rejection of claims 16-24 under 35 U.S.C. § 103(a) over Berry in view of Ross
in view of Camaisa in view of Roden in view of Rondeau and in view of Weber**

I. Regarding claim 16-24, Appellant did not identify any limitation that was not addressed in this claim apart from the limitation of claim 7 which has been addressed above. Appellant rather argues that it is legally insufficient to conclude that a claim is obvious just because each feature of the claim can be independently shown in cited prior art.

Examiner notes that KSR forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. See the Board decision *Ex parte Smith*, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007)(citing KSR, 82 USPQ2s at 1396).

In response to Appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,
Olabode Akintola /OA/
Art Unit 3691
24 April 2009

Conferees:

/Hani M. Kazimi/
Primary Examiner, Art Unit 3691

Vincent Millin /vm/
Appeals Conference Specialist